

REMARKS/ARGUMENTS

The Office Action mailed March 24, 2005 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-14.

Objection to Specification

On page 2 of the Office Action, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. The basis for the objection was that the specification is silent with respect to the claim elements of claims 2, 9, 10, 11, 12, and 13. The text of claims 2, 9, 10, 11, 12, and 13 is set out below:

2. (Original) The compact imaging spectrometer apparatus of claim 1 wherein said lens means for receiving said light, refracting said light, and focusing said light is a Germanium lens.

9. (Original) The compact imaging spectrometer apparatus of claim 1 wherein said immersed diffraction grating has a refractive surface and is an anamorphic asphere on its refractive surface.

10. (Original) The compact imaging spectrometer apparatus of claim 1 wherein said immersed diffraction grating has a grating surface and is spherical or aspheric on its grating surface.

11. (Original) The compact imaging spectrometer apparatus of claim 1 wherein said lens has a surface and is an anamorphic asphere on its surface.

12. (Original) The compact imaging spectrometer apparatus of claim 1 wherein said immersed grating consists of 2 or more prisms.

13. (Original) The compact imaging spectrometer apparatus of claim 1 wherein said lens consists of two or more lenses that are coaxial.

Applicant has amended the specification to include text from claims 2, 9, 10, 11, 12, and 13 in paragraph [0021]. Applicant believes this amendment provides proper antecedent basis for the claimed subject matter. Applicant points out that claims 2, 9, 10, 11, 12, and 13 were part of the original specification and the inclusion of text from claims 2, 9, 10, 11, 12, and 13 in paragraph [0021] does not add new matter to the application. Applicants believe that this amendment overcomes the Objection to the Specification in the Office Action mailed March 24, 2005.

Double Patenting

On page 3 of the Office Action, claims 1 and 3 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 2 of Co-pending Application 10/658,141.

On page 2 of the Office Action mailed March 24, 2005, It was stated, "A timely filed terminal disclaimer in compliance with 37CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application."

The Co-pending Application 10/658,141 and the subject application are commonly owned. Both the Co-pending Application 10/658,141 and the subject application are owned by The Regents of the University of California. The fact that the Co-pending Application 10/658,141 and the subject application are owned by The Regents of the University of California is established by assignments recorded in the United States Patent and Trademark Office.

Enclosed herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c), disclaiming the terminal portion of any patent issue from this application which would extend beyond the expiration date of the full statutory

term defined in 35 U.S.C. 154 to 156 and 173 of prior Co-pending Application 10/658,141.

Applicants believe they have provided a full and complete response to the obviousness-type double patenting rejections in the Office Action mailed March 24, 2005.

Allowable Subject Matter

On pages 3 and 4 of the Office Action, claims 2 and 4-14 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

As explained above, Applicant has submitted a terminal disclaimer to overcome the obviousness type double patenting rejection of claims 1 and 3. Since claims 1 and 3 are now allowable, Applicant believes that the objection to claims 2 and 4-14 has been overcome.

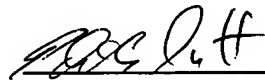
Note that claim 1 is the single (only) independent claim in the application and all of the other claims either directly or indirectly depend from claim 1. Since claim 1, the only independent claim in the application, is allowable, Applicant believes that claims 2-14 which depend from claim 1 are now in condition for allowance

Applicants believe that this amendment strictly complies with requirements in the Office Action mailed March 24, 2005; that all the objections and rejections set forth in the Office Action mailed Office Action mailed March 24, 2005 have been overcome; and that the application is in condition for allowance.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated March 24, 2005 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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